

### **REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 65-79 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; rejected claims 49 and 65 under 35 U.S.C. § 101; and rejected claims 33-47, 49-53<sup>2</sup>, 65-79, and 81-94 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,233,568 B1 to Kara ("Kara") in view of U.S. Patent No. 5,019,991 to Sansone et al. ("Sansone").

By this Reply, Applicants have amended claims 33, 36, 42-44, 49-52, 55, 58-60, 63, 65, 68, 74-76, 81, 84, and 89-91. Claims 1-96 are currently pending, with claims 1, 9, 17, 25, 33, 48, 49, 64, 65, 80, 81, 95, and 96 being independent. Claims 1-32, 48, 64, 80, 95, and 96 have been withdrawn from consideration as being non-elected. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections.

#### **I. § 112, Second Paragraph, Rejection of Claims 65-79**

The Examiner rejected claims 65-79 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action at 2. Applicants have

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<sup>1</sup> The Office Action contains a number of statements and declarations reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement, declaration, or characterization in the Office Action.

<sup>2</sup> Although the Office Action states that "[c]laims 33-47, 49-53, 65-79, and 81-94 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kara . . . in view of Sansone . . .," the Office Action appears to contain explanation for rejecting claims 33-47, 49-63, 65-79, and 81-94 under 35 U.S.C. § 103(a) as being unpatentable over Kara in view of Sansone. Office Action at 3-6. Applicants request clarification to ensure that they submit a complete response.

amended independent claim 65 to recite “[a] system for receiving payment for postage by a delivery system operator from a customer” to be consistent with the body of the claim, and claims 66-79 depend from amended independent claim 65. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of claims 65-79.

**II. § 101 Rejection of Claims 49 and 65**

The Examiner rejected claims 49 and 65 under 35 U.S.C. § 101 allegedly “because each of said claims include two statutory classes of invention: an apparatus and a process.” Office Action at 2. The Examiner asserted that “[c]laim 49 is directed to a system, while reciting various components providing certain functionality, which (components) can be understood as computer-readable instructions embedded in a computer-readable medium (a product of manufacture), or can be understood as merely software or code per se.” Office Action at 2-3. Although Applicants respectfully disagree, Applicants, in an effort to advance prosecution, have amended independent claim 49 to make the claim language more clear.

The Examiner also asserted that “[c]laim 65 is directed to a method while the body of the claim recites structural elements, thereby combining two mutually exclusive statutory classes of invention.” Office Action at 3. Applicants have amended claim 65 to remove the alleged inconsistency from the claim.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 49 and 65.

**III. § 103 Rejection of Claims 33-47, 49-53, 65-79, and 81-94**

Applicants respectfully traverse the rejection of claims 33-47, 49-53, 65-79, and 81-94 under 35 U.S.C. § 103(a) as being unpatentable over Kara in view of Sansone. A *prima facie* case of obviousness has not been established with respect to claims 33-47, 49-53, 65-79, and 81-94.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art] . . . [a]scertaining the differences between the claimed invention and the prior art; and . . . [r]esolving the level of ordinary skill in the pertinent art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of the level of ordinary skill.” M.P.E.P. § 2141(II).

Applicants respectfully submit that the § 103(a) rejection of claims 33-47, 49-53, 65-79, and 81-94 was improper because the Examiner failed to ascertain the differences between the claimed inventions and the prior art and resolve the level of ordinary skill in the pertinent art, as required by *Graham v. John Deere Co.* and M.P.E.P. § 2141. Instead, the Examiner merely stated what the cited references purportedly teach and that it would have been obvious to one having ordinary skill in the art to modify Kara to including the features of Sansone without resolving the level of ordinary skill in the art. Office Action at 4-6.

Furthermore, even if the *Graham* factual inquiries had been resolved, a *prima facie* case of obviousness has not been established with respect to claims 33-47, 49-53, 65-79, and 81-94. For example, amended independent claim 33 recites, among other things, “receiving from [a] customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel, the customer-determined attributes comprising at least one of height, length, and thickness of the parcel,” and “determining attributes of the parcel including at least one of height, length, and thickness of the parcel by [a] delivery system operator after the parcel is received by the delivery system operator for delivery.” Kara and Sansone, taken alone or in combination, fail to teach or suggest at least the recited elements.

The Examiner asserted that Kara teaches a weight as a parcel attribute. Office Action at 5. Nowhere does Kara, however, teach or suggest “receiving from [a] customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel, the customer-determined attributes comprising at least one of **height, length, and thickness of the parcel**,” as recited in amended independent claim 33. (emphasis added). Also, the Examiner correctly observed that Kara does not teach at least “determining attributes of the parcel by the delivery system operator,” as recited in original claim 33, among other things. Office Action at 4.

Sansone fails to cure these deficiencies of Kara. Sansone discloses “a scale for measuring weight of mail.” Sansone, col. 1, lines 63-64; col. 4, lines 18-22; FIG. 1 (items 28 and 30); FIG. 2 (item 1006); and FIG. 4 (item 208). Like Kara, however, nowhere does Sansone teach or suggest, “receiving from [a] customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel, the customer-determined attributes comprising at least one of **height, length, and thickness of the parcel**,” as recited in amended independent claim 33. (emphasis added).

In addition, although the Examiner asserted that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include determining attributes of the parcel by the delivery system operation” because Sansone “teaches a method and system for certifying correctly accounted postage payment, wherein the received mail pieces are placed in a feeder-stacker unit 14 (suggests the presence of the delivery system operator),” Sansone, nonetheless, fails to teach or suggest “determining attributes of the parcel including at least one of height,

length, and thickness of the parcel by [a] delivery system operator after the parcel is received by the delivery system operator for delivery,” as recited in amended independent claim 33. Office Action at 4.

Instead, Sansone teaches or suggests “certifying correctly accounted postage payment,” and “[t]he **certification** is placed upon the mail in human readable form [before the mail is received by the postal service for delivery] and thus **provides an indication to the postal service** [when received by the postal service for delivery] that appropriate adjustments have been made to the sender’s descending register balances for any short-weighted or short-paid or otherwise incorrect postage which may have been placed upon the envelope.” Sansone, Abstract and col. 4, lines 28-34. Thus, the certification of Sansone is not performed by the postal service, and thus Sansone does not suggest “the presence of the delivery system operator,” as asserted by the Examiner. Further, providing parameters and certifying the mail in the system of Sansone are performed at counter 26, scale 30, and certification station 48, further indicating that the system of Sansone operates before the mail is received by the postal service for delivery. Sansone, col. 4, lines 8-12. Therefore, Sansone fails to teach or suggest “determining attributes of [a] parcel including at least one of height, length, and thickness of the parcel by [a] delivery system operator after the parcel is received by the delivery system operator for delivery,” as recited by amended independent claim 33.

In view of the claimed elements missing from the cited references, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 33. Thus, the Examiner has failed to clearly articulate a reason why claim 33 would have been

obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 33 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Amended independent claims 49, 65, and 81, although of different scope, recite features that are similar to the features recited in amended independent claim 33. For reasons at least similar to the reasons set forth above with respect to independent claim 33, a *prima facie* case of obviousness has not been established with respect to independent claims 49, 65, and 81. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 49, 65, and 81 based on Kara and Sansone.

Claims 34-47 depend from amended independent claim 33; claims 50-63 depend from amended independent claim 49; claims 66-79 depend from amended independent claim 65; and claims 82-94 depend from amended independent claim 81. The dependent claims are allowable at least by virtue of their dependence from an allowable independent claim. Furthermore, the dependent claims recite further distinctions over the cited references. For example, claim 44 recites, among other things, "generating a credit when [a] second postage value is less than [a] first postage value," Claims 60, 76, and 91, although of different scope, recites features that are similar to the features recited in claim 44. Kara does not teach or suggest adjusting postage value, and the Office Action does not allege otherwise, as the Examiner correctly observed that Kara does not teach "transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values." Office Action at 4. Sansone fails to cure these deficiencies of Kara because Sansone teaches

"debiting [an] accounting system and/or advance deposit account for short paid [or short weight] mail," but does not teach or suggest crediting for overpaid and/or overweighed mail. Sansone, col. 2, lines 13, and 33-35; col. 4, lines 12-15. In fact, Sansone teaches away from crediting for overpayment. Sansone, col. 1, lines 12-15; col. 2, lines 7-14 and 33-35; FIG. 2.

For at least these additional reasons, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of dependent claims 34-47, 50-63, 66-79, and 82-94 based on Kara and Sansone.

#### IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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